

REMARKS

By this Amendment, claims 1-11 and 23-52 are now pending, with claims 1, 31, 32, 33, and 52 amended to correct the noted and discovered informalities. No new matter is introduced. Reconsideration in view of the above amendments and following remarks is respectfully requested.

The present Office Action rejects claims 1, 32, 33 and 52 under 35 U.S.C. §112, as being indefinite, objects to claims 32, 32 and 52 based on informalities, and rejects claims 1-11 and 23-52 under 35 U.S.C. §103, as being obvious in view of U.S. Patent Application No. 20020032612 to *Williams et al.* and U.S. Patent Application No. 20020065738 to *Riggs et al.*

In response to the rejection of claims 1, 32, 33 and 52 under 35 U.S.C. §112, as being indefinite, and the objection to claims 32, 32 and 52 based on informalities, claims 1, 31, 32, 33, and 52 have been amended to correct the noted and discovered informalities and so as to be in further compliance with 35 U.S.C. §112. No new matter is introduced. Accordingly, all of the pending claims are in compliance with 35 U.S.C. § 112 and no further rejection on such a basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to contact the undersigned attorney, who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

The pending claims are patentably distinguishable over *Williams et al.*, and *Riggs et al.*, because *Williams et al.*, and *Riggs et al.*, alone or in combination, fail to teach, disclose or suggest all of the features recited in the pending claims. For example, independent claim 1, as amended (emphasis added), recites:

A computer-implemented method for **processing shipment and return of a package containing items** from a Sender to a Recipient, the method comprising the steps of:

electronically storing package data, for the package, and including item data, for the items in the package, in a database;

electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism;

electronically adding the shipment tracking data to the database;

electronically correlating the package data in the database with the shipment tracking data for the package; and

permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package.

independent claim 33, as amended (emphasis added), recites:

A computer-implemented system for **processing shipment and return of a package containing items** from a Sender to a Recipient, the system comprising:

means for **electronically storing package data, for the package, and including item data, for the items in the package**, in a database;

means for electronically retrieving shipment tracking data, for **tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender**;

means for electronically adding the shipment tracking data to the database;

means for **electronically correlating the package data in the database with the shipment tracking data for the package**; and

means for **permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package**.

Thus, the pending independent claims 1 and 33 are directed to a novel method and system for processing **shipment and return** of a package containing items, wherein, advantageously, everything can be tied to the contents (i.e., items) of a package being shipped, by **correlating package data, for the package, and including item data, for the items in the package, with shipment tracking data for the package**. Advantageously, “returns can be handled on an item-by-item basis, rather than on a shipment-by-shipment basis,” “items are correlated to an accurate description thereof to facilitate customs clearance of each item,” and “[e]ach package, and each item in each package, can be tracked and the results made available over a network, such as the Internet” (see, e.g., Specification, p. 4, ¶ [0017]). None of the applied references teach or suggest the noted features or advantages of the inventions recited in independent claims 1 and 33.

For example, *Williams et al.* merely deals with returns, which is only a part of the inventions recited in claims 1 and 33. *Riggs et al.* also fails teach or suggest the noted features or advantages of the inventions recited in claims 1 and 33. Accordingly, the inventions recited in claims 1 and 33 are patentably distinguishable over *Williams et al.*, and *Riggs et al.*, alone or in combination.

In addition, prior art shipping companies normally treat individual packages as the important units, and are not concerned with the contents in terms of their shipping processes. The inventions recited in claims 1 and 33, on the other hand, care primarily about the package contents, and track each item in a given package throughout the shipping process and, if necessary, throughout a returns process.

Further, as compared with the system of *Williams et al.*, a returns process of the inventions recited in claims 1 and 33, advantageously, need not employ further participation from the company that shipped the goods, as the items in each package are tracked and correlated, and a return can be processed without having to integrate with an order system of the shipper, with a customer who received and returned the goods simply filling out a form accompanying the returned goods.

Accordingly, the present invention recited in independent claims 1, and 33 includes recognition of problems discovered with respect to conventional shipping and return systems, as described in Applicant's published Specification, for example, as follows:

[0007] However, the prior art fails to provide a flexible solution for facilitating shipment of items in packages from one destination to another. For example, the prior art provides no flexible means for tracking individual items shipped via a shipper for handling returns or the like. This shortcoming is particularly problematic for international shipments that may be subject to the assessment of duties, taxes and/or customs fees.

The present invention recited in independent claims 1, and 33, advantageously, addresses the discovered problems with respect to conventional shipping and return systems, as described in Applicant's published Specification, for example, as follows:

[0017] A preferred embodiment of the invention is a shipment data tracking system and method in which each item in an order can be tracked individually, regardless of the physical package in which it is shipped. Accordingly, returns can be handled on an item-by-item basis, rather than on a shipment-by-shipment basis. The Sender can easily refund all charges, including any duties, taxes, or customs fees that were assessed, upon return of the item or the package. Further, items are correlated to an accurate description thereof to facilitate customs clearance of each item. Detailed shipment information is entered and stored in a central database. Each package, and each item in each package, can be tracked and the results made available over a network, such as the Internet. This audit trail allows the Sender, the Recipient, or any other authorized user to query the database and view shipping and return information, including package information, tracking information, invoices, pending refunds, and the like. Furthermore,

forms can be requested from the database via the Internet and subsequently printed by an authorized user. Such forms may include address labels, shipping labels, customs manifests, and related documents.

By contrast, *Williams et al.*, and *Riggs et al.*, taken alone or in combination, neither teach, disclose nor suggest the noted features recited in independent claims 1, and 33, nor recognize or address the discovered problems with respect to conventional shipping and return systems. Accordingly, one of ordinary skill in the art would find no motivation to arrive at the invention recited in independent claims 1, and 33, based on *Williams et al.*, and *Riggs et al.*, absent improper hindsight reconstructions of Applicant's invention based on Applicant's disclosure.

In addition, submitted herewith is a Declaration under 37 C.F.R. § 1.132 regarding the commercial success of Applicant's claimed invention, as recited in independent claims 1, and 33. As the Supreme Court established in *Graham v John Deere Co.*, such "Secondary Considerations," including commercial success, wherein the real world puts a high value on the invention, are an objective indication that a claimed invention is not obvious, and can be submitted to overcome an obviousness rejection, as in the present case. Accordingly, the invention recited in independent claims 1, and 33 is not obvious in view of *Williams et al.*, and *Riggs et al.*, taken alone or in combination, as evidenced by the commercial success thereof.

The dependent claims are allowable over *Williams et al.*, and *Riggs et al.*, alone or in combination, on their on merits and for at least the reasons as argued above with respect to independent claims 1 and 33.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §§ 112 and 103, the present amendment places the application in better form for consideration on appeal. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

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